Docket No.: BULK 3.3-015

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Patent Application of: Kamalakar TALASILA et al.	:	
Application No.: 10/510,064	:	Group Art Unit: 1625
Filed: February 13, 2006	:	Examiner: Chang, Celia C.
For: ANTIHISTAMINE DECONGESTANT COMPOSITIONS	:	

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF

Sir:

This paper is submitted in response to the Examiner's Answer dated October 20, 2010, for the above-identified application. Submission of a reply brief in this case is due by December 20, 2010. Accordingly, this paper is being timely filed. Appellants respectfully request that the following remarks be considered.

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1. Status of the Claims

Claims 18-37 were finally rejected in an Office Action mailed on February 19, 2010 ("the final Office Action"). Claims 1-17 were previously cancelled. The Examiner indicated in the Examiner's Answer that claim 37 had been found allowable.

2. Grounds of Rejection to be Reviewed on Appeal

A. Whether claims 18-36 reading on the elected subject matter are invalid under 35 U.S.C. § 112, first paragraph, for failing to comply with the enablement requirement.

B. Whether claims 18-36 reading on the elected subject matter are unpatentable under 35 U.S.C. § 103(a) over MacLaren et al., US 6,039,974 ("MacLaren"), in view of Pharmapedia, 2009 ("Pharmapedia") or Ahjel, 2008 ("Ahjel"), further in view of Edgren et al., US 6,210,712 ("Edgren") and Buhler, 2009 ("Buhler").

3. Argument

Appellants maintain that each of the Examiner's remaining rejections is in error and should be reversed.

A. The Examiner maintained the rejection of claims 18-36, wherein the antihistaminic drug is crystalline Form X of fexofenadine hydrochloride and the decongestant drug is pseudoephedrine, under 35 U.S.C. § 112, first paragraph, for allegedly failing to comply with the enablement requirement. The Examiner, while accepting that claim 37 is enabled, apparently believes that the generic nature of one or more of the excipients in claims 18-36 renders those claims non-enabled in view of the teachings of the specification. In particular, the Examiner stated that "While specific carrier can keep measurable amount of a particular crystalline form, it is well recognized facts that ordinary pharmaceutical carrier or unlimited wet processing would not be operable."

The Examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. *See In re Wright*, 999 F.2d 1557, 1562 (Fed. Cir. 1993). The Examiner has not done so here. The Examiner has provided no objective evidence for the proposition that "ordinary pharmaceutical carrier or unlimited wet processing would not be operable" to provide crystalline Form X of fexofenadine hydrochloride. Indeed, claim 37, which the Examiner agrees is enabled, recites "ordinary pharmaceutical carrier[s]" such as cellulose, starch and mannitol.

As explained in MPEP § 2164.04, a specification disclosure which contains a teaching of the manner and process of making and using an invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as being in compliance with the enablement requirement unless there is a reason to doubt the objective truth of the statements contained therein which are relied on for enabling support.

Applicants were well aware of the problem of polymorphic conversion during drug formulation, as evidenced by the following passage from the specification:

> The low solubility and physicochemical properties of Fexofenadine hydrochloride imposes the problem in formulation and bioavailability. Moreover, the polymeric conversion is most common still challenging aspect to the formulation scientists to ensure product quality and organoleptic properties. Therefore the selection of proper formulation technique is crucial to ensure better stability and bioavailability of the final dosage form.

Page 9, line 35 to page 10, line 5.

Applicants addressed this problem by disclosing formulation techniques and materials capable of providing pharmaceutical compositions comprising crystalline Form X of fexofenadine hydrochloride in usable form (see, e.g., Example 1), the same techniques and materials recited in claims 18-36. Applicants concluded that the "***techniques are robust enough to assure the product quality characteristic in routine manufacturing***" (page 10, lines 5-6). Notwithstanding the Office's reliance on references purportedly showing the unpredictable nature of crystalline drug formulation, the Examiner has provided no reason to doubt the objective truth of this statement. As such, Applicants' disclosure must be taken as in compliance with the enablement

requirement. *See Ex parte Reddy*, Appeal No. 2009-000439, for U.S. Patent Application No. 10/505,826, at 23 (BPAI 2009) ("If anything, the disclosures cited by the Examiner suggest that a skilled artisan knew what actions to avoid when formulating sensitive polymorphic forms, and if encountering problems, what actions might be taken to rectify them.").

The Examiner's main concern continues to be that processing crystalline forms of drugs into a pharmaceutical dosage form could result in the transformation into a different crystalline form. However, the Examiner has provided no evidence that this is the case with crystalline Form X of fexofenadine hydrochloride. *See Reddy*, *supra* ("While it may be true that polymorphic forms can undergo undesirable changes when formulated into dosage forms, the Examiner has not explained . . . why the *claimed* crystalline forms would be subject to these problems.") (emphasis in original).

In any event, as explained in Appellants' Appeal Brief, nothing in the examined subject matter requires that crystalline Form X be maintained indefinitely in the composition, or that it even be the only form present in the composition, and it is error for the Examiner to read such limitations into the claims. Applicants specifically provided examples in the specification showing the preparation of pharmaceutical compositions comprising crystalline Form X of fexofenadine hydrochloride, as well as methods for monitoring any potential polymorphic transformation (i.e., X-ray powder diffraction). Thus, any experimentation needed to make and use the claimed subject matter would not be undue. *See Reddy*, *supra* ("[B]ecause the Specification lists the solid formulations and excipients suitable for the crystalline forms X and Y we agree . . . that a person of ordinary skill in the art would have understood Appellants to be in

possession of the [claimed] subject matter . . . [and] that any experimentation that would be required to prepare the claimed pharmaceutical compositions would be routine in nature, rather than undue.").

Since the specification teaches how to make and use pharmaceutical compositions comprising crystalline Form X of fexofenadine hydrochloride without undue experimentation, Appellants maintain that claims 18-36 reading on the elected subject matter satisfy the enablement requirement, and reversal of the rejection is respectfully requested.

B. The Examiner maintained the rejection of claims 18-36, wherein the antihistaminic drug is crystalline Form X of fexofenadine hydrochloride and the decongestant drug is pseudoephedrine, under 35 U.S.C. § 103(a) as allegedly unpatentable over MacLaren in view of Pharmapedia or Ahjel, further in view of Edgren and Buhler. The § 103 rejection is based primarily on the Examiner's mistaken belief, discussed above, that the instant specification fails to adequately enable the making and using of pharmaceutical compositions crystalline Form X of fexofenadine hydrochloride to the full extent recited in claims 18-36. Thus, according to the Examiner, "ordinary pharmaceutical carrier or wet processing such as McLaren's without mannitol would not maintain any crystalline form."

However, as with the enablement rejection discussed above, the Examiner has provided no objective evidence for the proposition that "ordinary pharmaceutical carrier or wet processing . . . without mannitol would not maintain any crystalline form." It is merely a conclusory statement. As discussed above, Applicants addressed the problem of polymorphic conversion by providing formulation techniques and materials capable of

providing pharmaceutical compositions comprising crystalline Form X of fexofenadine hydrochloride in usable form without undue experimentation, concluding that the "***techniques are robust enough to assure the product quality characteristic in routine manufacturing***." Again, the Examiner has provided no reason to doubt the objective truth of this statement. As such, reading MacLaren to cover the claimed composition improperly ignores a critical limitation of the examined subject matter, namely that the fexofenadine HCl be crystalline Form X. *See Ex parte Glover*, Appeal No. 2006-2861, for U.S. Pat. Appl. No. 10/007,272, at 5 (BPAI 2007) ("[T]he claimed invention differs from the disclosure of Chamberlain in that the claims specifically recite a *crystalline* form of the compound. The rejection improperly ignores this element of the claims.") (emphasis in original).

Since none of the references relied on by the Examiner would have suggested crystalline Form X of fexofenadine hydrochloride, or a method for its preparation, Appellants maintain that claims 18-36 reading on the elected subject matter are not unpatentable under § 103, and reversal of the rejection is respectfully requested.

CONCLUSION

For the foregoing reasons, Appellants maintain that each of the Examiner's remaining rejections is in error, and reversal of the rejections is therefore appropriate and is respectfully solicited.

Date: November 17, 2010

Respectfully submitted,

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